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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,170	09/11/2003	Sun Sasongko	7186	7600

7590 02/24/2005

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EXAMINER	
TRAN, THAO T	

ART UNIT	PAPER NUMBER
1711	

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/660,170	SASONGKO ET AL.	
	Examiner	Art Unit	
	Thao T. Tran	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 January 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This is in response to the Amendment filed January 3, 2005.

2. Claims 1-6 are currently pending in this application. Claim 3 has been amended.

Claim Objections

3. In view of the prior Office action of June 29, 2004, the objection to claim 3 has been withdrawn due to the Amendment made thereto.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3 and 5-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Sasongko (US 2003/0124347).

Sasongko teaches a two-layered adhesive film for bonding non-polar materials to polar materials in footwear assemblies which comprises an inner thermoplastic polyurethane based adhesive adapted to bond to a polar material and an outer ethylene copolymer based adhesive

adapted to bond to a non-polar material. The outer adhesive is interfaced with the inner adhesive. (See abstract). The two adhesive layers are interfacially bonded by coextrusion (see 0007).

Sasongko further teaches the outer adhesive layer comprising acid or acrylic or anhydride modified ethylene copolymers; while the inner adhesive layer comprising thermoplastic polyurethanes or polyurethane acrylates and polyesters (see 0012-0013).

Sasongko teaches the non-polar material being ethylene copolymer (see claim 7).

Sasongko further teaches each of the adhesive film having a thickness of between about 0.0005 to abut 0.005 inches (see claim 10).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sasongko as applied to claims 1-3 above, and further in view of Strickland et al. (US Pat. 5,820,719).

Sasongko is as set forth in claims 1-3 above and incorporated herein.

Sasongko teaches the polar material to be leather or fabric (see 0013). However, Sasongko does not teach the polar material to be synthetic as recited in the instant claim.

Strickland teaches the use of leather, fabric, or synthetic as alternatives as the polar material in the upper (see col. 2, ln. 26-27). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have employed a synthetic

material, such as PVC or urethane, as taught by Strickland, in the invention of Sasongko. The use of PVC or urethane material would have given the same effects because Strickland teaches that the thermoplastic polyurethane adhesive would work as equally well with PVC or urethane as with leather or fabric.

Response to Arguments

8. Applicant's arguments filed January 3, 2005 have been fully considered but they are not persuasive.

On page 4 of the Remarks, Applicant contends that Sasongko '347 teaches a different adhesive because it is used to bond material such as leather or fabric. Applicant further argues that Sasongko '347 does not teach the adhesive to bond two polymeric upper and sole materials. However, as pointed out in the prior Office action and paragraph 5 above, Sasongko '347 does teach a two-layered adhesive film for bonding non-polar materials to polar materials, comprising the same compositions as recited in the presently claimed invention. Thus, what Sasongko '347 teaches anticipates the presently claimed invention.

Furthermore, as to the use of the adhesive in bonding, it has been within the skill in the art that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d

576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

9. In response to applicant's argument, on page 5 of the Remarks, that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Strickland is used to illustrate that leather, fabric, and synthetic material has been taught in the prior art as alternative polar materials in the upper, which is adhered to a polyurethane film. Thus, the combination of Sasongko and Stricland is proper.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thao T. Tran whose telephone number is 571-272-1080. The examiner can normally be reached on Monday-Friday, from 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tt
February 22, 2005

Thao Tran

THAO T. TRAN
PATENT EXAMINER